

REMARKS

Applicants have amended claims 1, 3, 5, 7-10, 12-15, and 22-33, and have cancelled claims 2-25, during prosecution of this patent application. Applicants are not conceding in this patent application that the subject matter encompassed by said amended and cancelled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicants respectfully reserve the right to pursue the subject matter encompassed by said amended and cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

Applicants request that the Examiner acknowledge Applicants' claim for priority under 35 U.S.C. 371. The present office action mailed 08/18/2009 incorrectly states that Applicants have claimed priority under 35 U.S.C. 119.

The Examiner rejected claims 1-21, 24 and 26 under 35 U.S.C. § 101.

The Examiner rejected claims 1-26 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sudia et al. US Patent No.: 5,995,625 (hereinafter Sudia) and further in view of Koyama et al. US Pub. No.: 2002/0116382 A1 (hereinafter Koyama).

Applicants respectfully traverse the § 101 and § 103 rejections with the following arguments.

35 U.S.C. § 101: Claims 1-21, 24 and 26

The Examiner rejected claims 1-21, 24 and 26 under 35 U.S.C. § 101.

Since claims 2-21, 24, and 26 have been cancelled, the rejection of claims 2-21, 24, and 26 under 35 U.S.C. § 101 is moot.

As to claim 1, the Examiner argues: "Claim 1 recites *"A method for generation a conditional electronic signature"* comprising steps that may be performed manually and/or mentally. Thus, the recited method is not tied to a particular machine or apparatus. Additionally, none of the recited steps transform a particular article into a different state or thing."

In response, Applicants have amended claim 1 to recite and individual step being performed by a particular machine, namely a computer that performs the "iteratively processing" step, in compliance with the machine prong of the machine-or-transformation test set forth by the Federal Circuit in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc).

Accordingly, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 101 be withdrawn.

35 U.S.C. § 103(a): Claims 1-26

The Examiner rejected claims 1-26 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sudia et al. US Patent No.: 5,995,625 (hereinafter Sudia) and further in view of Koyama et al. US Pub. No.: 2002/0116382 A1 (hereinafter Koyama).

Since claims 2-26 have been cancelled, the rejection of claims 2-26 under 35 U.S.C. § 103(a) is moot.

Applicants respectfully contend that claim 1 is not unpatentable over Sudia and further in view of Koyama, because Sudia and further in view of Koyama does not teach or suggest each and every feature of claim 1.

For example, Sudia and further in view of Koyama does not teach or suggest the feature:

“hashing the data item to generate a digest of the data item;

hashing each condition of the one or more conditions separately from each other and separately from the data item to generate one or more condition digests respectively corresponding to the one or more conditions;

setting a reference digest equal to the digest of the data item;

a data processing apparatus iteratively processing a unique condition digest of the one or more condition digests in each iteration of a loop for a sufficient number of iterations to process all of said condition digests, said processing in each iteration comprising *concatenating the reference digest with the unique condition digest of the iteration to generate a concatenand and hashing the concatenand to generate a hashed concatenand that serves as the reference digest for the next iteration if the next iteration is performed*, each unique condition digest being a different condition digest in each iteration of the loop, the regenerated reference digest of the last iteration of the loop being a last digest; and

encrypting the last digest to generate a digital signature block that represents the data item and the one or more conditions and enables cryptographic verification of both the data item and the one or more conditions, said encrypting comprising signing the last digest with a digital signature” (emphasis added)

The preceding feature of claim 1 requires generating a hashed concatenand by hashing a concatenand that is formed as a concatenation of a reference digest (formed from a hash of a data item) with a condition digest (formed from a hash of a condition).

Applicants note that Sudia discloses forming a wrap key value 30 by combining various digests which include a digest 20 formed as a hash of an acceptance phrase 16 and a digest 14 formed as a hash of conditions 10 (see Sudia, col. 3, lines 13-62). However, Sudia does not disclose that the digests are combined *by being concatenated* to form the wrap key value 30 and Sudia does not disclose that the wrap key value 30 is *hashed*. Therefore, Sudia does not disclose the preceding feature of claim 1.

In addition, Sudia does not disclose the claimed loop of iterations with each hashed concatenand being the reference digest in the next iteration. Therefore, Sudia does not disclose the preceding feature of claim 1.

Based on the preceding arguments, Applicants respectfully maintain that claim 1 is not unpatentable over Sudia and further in view of Koyama, and that claim 1 is in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM).

Date: 11/12/09

/ Jack P. Friedman /
Jack P. Friedman
Registration No. 44,688

Customer No. 30449
Schmeiser, Olsen & Watts
22 Century Hill Drive - Suite 302
Latham, New York 12110
Telephone (518) 220-1850
Facsimile (518) 220-1857
E-mail: jfriedman@iplawusa.com